



Atty. Dkt. No. 074129-0521

CZE

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Kouhei TOYOOKA et al.  
Title: ISOINDOLINE DERIVATIVES  
Appl. No.: 10/534,414  
International Filing Date: 11/25/2003  
371(c) Date: 05/11/2005  
Patent No.: 7,521,451  
Grant Date: 4/21/2009  
Examiner: Noble E. JARRELL  
Art Unit: 1624  
Conf. No. 7101

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**  
**UNDER 37 C.F.R. §1.705**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 4/21/2009 as U.S. Patent No. 7,521,451.

This Request is filed within two months of the Letter Regarding PTA mailed by the US PTO on March 16, 2009. Reconsideration of the 15 day reduction in PTA discussed in said Letter is requested. The commencement date of July 27, 2006 mentioned in the fourth paragraph of said Letter is clearly erroneous. The commencement date of the present application is 14 months from the date of receipt of all requirements under 35 USC 371, which is July 11, 2006. As clearly indicated on the form PCT/DO/EO/903 (Notice of Acceptance), the date of receipt of

all requirements under 35 USC 371 in the present application is May 11, 2005, 14 months from which is July 11, 2006. It is respectfully requested that the 15 day reduction taken with the mailing of the Letter Regarding PTA mailed on March 16, 2009, was in error.

The Patent Office determined that the patent was entitled to 404 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 764 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 787 days

(b) Total Applicant delay: 23 days

Final PTA Determination: 764 days

Applicants therefore respectfully request that the patent be accorded 764 days PTA.

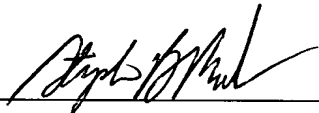
The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute and in determining the commencement date of the application, a refund of the fee is respectfully requested.

Respectfully submitted,

Date APR 24 2009

By 

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Docket Number: 074129-0521  
 Application Number: 10/534414  
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	11/26/2002	-897		
Edit Delete	International Filing Date	11/25/2003	-533		
Edit Delete	National Stage Entry (All 371(c) Requirements Met)	05/11/2005	0		
	PCT National Stage Commencement Date	05/11/2005	0		
	14 month From Application date	07/11/2006	426		
Edit Delete	Restriction Requirement	09/26/2007	868	442	
Edit Delete	Restriction Requirement Response Received at PTO	10/26/2007	898		
Edit Delete	Non-Final Office Action	11/23/2007	926		
	Non-Final Office Action + 3 months	02/23/2008	1,018		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	02/25/2008	1,020		2
	3 Year Period Starts	05/11/2008	1,096		
Edit Delete	Final Office Action	05/29/2008	1,114		
	Final Office Action + 3 months	08/29/2008	1,206		
Edit Delete	Final Office Action Response Received at PTO	09/19/2008	1,227		21
Edit Delete	Notice of Allowance	10/06/2008	1,244		
Edit Delete	Issue Fee Paid	12/30/2008	1,329		
Edit Delete	Patent Grant Date	04/21/2009	1,441	345	
			Totals:	787	23
			PTA:	764	

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IP: 10.14.41.173

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